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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/375,154	05/23/2000	Paul Lapstun	NPT001US	9107

7590

07/03/2003

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EXAMINER
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ST CYR, DANIEL

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 07/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/575,154

Applicant(s)

LAPSTUN ET AL.

Examiner

Daniel St.Cyr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-107 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-107 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/26/03 has been entered.

### *Specification*

2. The specification of the disclosure is objected to because on page 1, lines 14-31, the applicant failed to provide the filing date of the copending applications, including Patent issued date when applicable. Correction is required.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-107 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman, US Patent No. 6,330,976, in view of Heckman et al, US Patent No. 5,291,243.

Re claims 1-54, 58-99, and 103-107, Dymetman et al disclose a marking medium area with encoded identifier for producing action through network comprising: a coded substrate supplier used to produce machine-readable markings. The coded substrate includes invisible markings on paper, which is nonetheless detected by the detection circuitry in a pointer device. Ultra-violet (UV) ink is used to print invisible markings on white paper. The coded substrate supplier could produce sheets of paper in different formats for different uses by the publishing industry. Each sheet can be processed through a specialized printing procedure which (1) assigns a fresh page-identifier (and possibly page-id-code) to the sheet, and (2) prints in UV ink machine-readable markings encoding the page-identifier (and possibly page-id-code) on the surface of the sheet. In standard trichromatic printing, three layers of coloured inks (yellow, magenta, and cyan) are superposed to produce all visible colours. Each layer filters one part of the light spectrum independently of the others. An encoded representation of the page-identifier, i.e. an item of data whose value uniquely identifies the page, within cell border 204, such as a first set of markings 208; and an encoded representation of location information, such as a location code uniquely defining the position of cell 202 within the page, within cell border 204, such as a second set of markings 210, illustratively smaller in size than first set 208 (see col. 11, line 5+, col. 13; figures 1-3, 7, 8).

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Dymetman et al teach a document 102 printed on a code substrate 106 comprises a visible printed layer 104 (text, photograph image or any human readable information), an invisible machine-readable marking 108 sprinted on a sheet 110, but fail to disclose or fairly suggest the visible information and the invisible information are disposed on the surface substantially simultaneously.

Herkman et al disclose a system for electronically printed plural-color temper-resistant documents, wherein at least two colors are simultaneously printed on a security document ( see col. 11, line 55+).

In view of Herkman et al's teachings, it would have been obvious for a person of ordinary skill in the art at the time the invention was made to modify the system of Dymetman et al so that both information could be simultaneously and/or separately printed each information onto the document. Such modification would enhance the system capability by expediting the printing process and would be more practical wherein the system could be used to print in-house secured documents with both information printed thereon and commercial documents having the invisible code to identify each page of the documents, which would make the system more effective. Therefore, it would have been an obvious extension as taught by Dymetman et al.

Re claims 55-57 and 100-102, Dymetman et al as modified by Heckman et al. The teachings of Dymetman et al as modified by Heckman et al have been discussed above.

Dymetman et al as modified by Heckman et al fails to disclose or fairly suggests the specific dimension of the region and the specific layout of the coded data for identifying the region, as set forth in the claims.

However, such specific limitations fall within the engineering design choice.

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It would have been obvious for a person of ordinary skill in the art at the time the invention was made to design the medium of Dymetman as modified by Heckman et al into the specific dimension/layout for meeting specific design requirements. Furthermore, these specific dimension and layout does not provide any unexpected results. Therefore, it would have been an obvious extension as taught Dymetman et al as modified by Heckman et al.

*Response to Arguments*

6. Applicant's arguments with respect to claims 1-107 have been considered but are not persuasive (see examiner remarks).

**REMARKS:**

In response to the applicant's remarks on page 2 that the examiner has utterly failed to fulfill his duties under US Patent Law and USPTO practice, the examiner respectfully disagrees. Let's make the record clear.

- a. On April 19, 2002 a non-final Office action was mailed.
- b. On September 13, 2002 an amendment was received.
- c. On November 25, 2002 a final Office action necessitated by the amendment was mailed. The independent claims 1 and 59 were amended.
- d. On March 25, 2003 an amendment/response was filed.
- e. On April 21, 2003 an advisory action was mailed.

The examiner clearly fulfilled his duties, the amendment/response was filed after the final Office action, which the examiner responded with an the advisory action.

In response to the applicant arguments filed March 25, 2003, the examiner respectfully disagrees.

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1. The applicant stated that claims 1-54, 58-99, and 103-107 as being anticipated by Dymetman et al (US 6,330,976) in view of Heckman, the examiner respectfully disagrees. The claims are rejected **under U.C.C. 103(a) as being unpatentable over** Dymetman in view of Heckman.

a) The applicant agreed in part with the examiner rejection.

b) The applicant argued that Heckman does a region in which a region in which "the coded data and the additional data having been disposed on the surface substantially simultaneously" and in which "the coded data comprises machine-readable data which is substantially inscrutable to the average unaided human".

The examiner's position is that Heckman was used to supplement Dymetman for the **printing process** in a U.S.C. 103(a) rejection. In response to this argument against the references individually, the applicant is reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

2. In response to the applicant remarks that the examiner may be confusing figure 4 of Dymetman with the figure 4 of Heckman, the examiner respectfully disagrees. Figure 4 of Dymetman illustrates components of document printed on code substrate, which include **both visible and invisible data** (see col. 12, line 59+). This shows that Dymetman does not teach away from printing both data onto the substrate.

3. In response to the applicant's remarks that the examiner has clearly ignored a large number of claims in the examination, the examiner respectfully disagrees. Every claim was

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examined and the examiner is certain that prior art covers all the limitations in the claims.

Furthermore, no specific arguments have been raised by the applicant regarding any specific claim.

4. In response to applicant argument, the objection has been withdrawn.

5. In response to the applicant's argument regarding the final Office dated 11/25/02, the examiner respectfully disagrees. The fact both the tags and the additional information are printed on the same printer is not the same as being simultaneous printing of coded and additional data.

b. In response to the applicant's remark regarding prior art search, the examiner respectfully disagrees. This application has both US and foreign prior art references cited therein. All of the applicant concerns have been addressed. Should the applicant has any further arguments and concerns, the applicant is invited to raise them in the response following this action.

The applicant arguments are not persuasive. Refer to the rejection above.

### *Conclusion*

7. This is a RCE of applicant's earlier Application No. 09/575,154. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

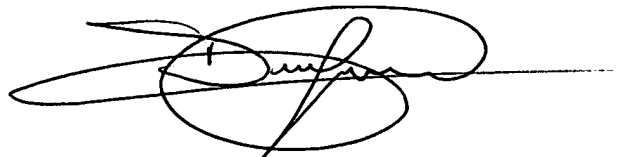
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St.Cyr whose telephone number is 703-305-2656. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7721 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Daniel St.Cyr  
Primary Examiner  
Art Unit 2876

DS  
June 30, 2003

A handwritten signature in black ink, appearing to read 'Daniel St.Cyr', is written over a horizontal line. The signature is stylized with loops and a long horizontal stroke extending to the right.